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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/298,763

04/23/1999

RAHN WOOD

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7590
Kenyon & Kenyon
ONE BROADWAY
NEW YORK, NY 10004

05/28/2008

EXAMINER

CHAMPAGNE, DONALD

ART UNIT

PAPER NUMBER

3688

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/298,763	Applicant(s) WOOD ET AL.	
	Examiner Donald L. Champagne	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 25 February 2008 have been fully considered but they are not persuasive. The arguments are addressed are para. 18-22 below. The examiner has changed the basis of rejection for claims 1, 6 and 20 and their dependents (para. 6 and 8 below). The following rejection has accordingly been made non-final.

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5-13, 16-22, 24, 25 and 38 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as unpatentable over Jovicic et al. (US005855007A).

5. Jovicic et al. teaches (independent claims 1, 17, 19, 20 and 38) a computer- implemented method and system for interactively and electronically distributing and redeeming rewards, the method comprising:

displaying a graphic of an electronic coupon (col. 8 line 10-11 and col. 6 lines 49-55), which reads on an advertising image and a promotional incentive, comprising a reward

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indicator and a reward identifier¹, on a computer screen of a local computer (*Internet node 102*, col. 7 lines 41-43), wherein the local computer is coupled to a computer network (col. 5 lines 24-26);

enabling a user to select the image (col. 8 lines 10-11);

at a central location (*Internet Coupon Server 124*) coupled to the computer network (col. 6 lines 4-5), seamlessly determining the identity of the user (col. 2 lines 49-52) when said image is selected;

at the central location, automatically allocating a reward associated with the advertising image when said image is selected (inherently, because the advertising/*electronic coupon 302* comprises a reward¹), wherein said allocating step includes storing a reward identifier (*coupon serial number 318*) with the identity of the user (*customer's/user's name data 320*, col. 7 lines 24-40) in a central database (*coupon data base 130*, col. 8 lines 48-49), said reward indicator (presumably this means reward "identifier") identifying a promotional incentive, said central database being accessible by the user enabling the user to view a list of rewards (in *browsing memory 128*, col. 6 lines 11-13) that have been allocated to the user and enabling the user to select a reward for redemption from the list of rewards.

6. The "optional" language at the end of claims 1 and 6 is ignored because "optional" claim language does not limit (MPEP § 2111.04). For independent claim 19, the two clauses beginning with "if" are also not limiting.
7. Jovicic et al. does not explicitly teach that the purpose of the method and system is increasing the click-through rate for advertisements/to attract traffic to a promoter computer. However, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that the purpose of all advertising is product promotion, of which targeted promotion distribution is an important element. Success is measured by the number of coupons that are selected and used, which reads on increasing the click-through rate for electronic coupons/advertisements or attracting traffic to the

¹ To one of ordinary skill in the art, "advertising" is anything that promotes. A coupon is a kind of incentive or "promotional incentive". In this case the coupon describes the product being promoted and the promoter/advertiser (*owner*, col. 6 lines 49-55), so it advertises the product and its promoter/advertiser. The coupon includes *discount information 302*, which reads on a "reward indicator". "Reward identifier" does not appear to be disclosed in the specification; it is interpreted as synonymous with coupon ID (taught as *coupon serial number 318*).

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promoter computer. Alternatively, because promotion success is commonly measured by increases in click-through rate, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Jovicic et al. that the method and system be practiced to increase the click-through rate for advertisements/to attract traffic to a promoter computer.

8. Jovicic et al. also teaches (claim 20), without pre-registration of a (new) user, where pre-registration is interpreted as registration before the present online session. Jovicic et al. also teaches a list of rewards (the *coupons* stored in *browsing memory 128*, col. 6 lines 11-13) previously collected by the user (para. xx below). Alternatively, no patentable weight was given to “collected by the user” because it is nonfunctional descriptive material (MPEP § 2106.01): In the sense used in the patent law (35 USC 101), “collected by the user” is not functional because it neither “tied to a particular apparatus” nor “operates to change materials to ‘a different state or thing’” (*IN RE COMISKEY*, CAFC 2006-1286, September 2007). See para. 22 below.
9. Jovicic et al. also teaches at the citations given above claims 5, 6 and 25. The reference also teaches claims 7, 22 and 24 (col. 3 line 27); claims 8-11 and 18 (col. 3 line 13 and col. 6 line 54); claim 12 (col. 6 line 51); claim 16 (col. 2 line 44) and claims 21 (col. 7 lines 12-14). The reference also teaches claim 13 inherently as the home page of the Internet Coupon Server (col. 6 lines 5-6).
10. Claims 2-4, 14-15, 23, 26-31 and 39 are rejected under 35 USC 103(a) as obvious over Jovicic et al.
11. Jovicic et al. does not teach (claims 2-4 and 23) storing the user ID number in a cookie/local computer datafile. Because cookies were well-known user conveniences, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add storing the user ID number in a cookie/local computer datafile to the reference invention.
12. Jovicic et al. does not teach (claims 26-31) the user device limitations of these claims (ATM, PDA, etc.). However, the user does teach the genus *general-purpose digital computer* and a PC (col. 5 lines 26 and 41-42). Because the claimed devices were well known and convenient user computers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add these user computers to the reference invention.

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13. Jovicic et al. does not teach (claims 14-15) ID input by magnetic stripe or smart card.

Because this is an inherent and convenient means for input with some of the obvious claimed user computers (e.g. ATM), it would have been inherent, or alternatively obvious to one of ordinary skill in the art, at the time of the invention, to input the ID by magnetic stripe or smart card.

14. Jovicic et al. does not teach (claim 39) means to transfer a reward to another registered user. Because this would be an attractive user feature easily implemented with the reference invention, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add means to transfer a coupon reward to another registered user to the teachings of Jovicic et al.

15. Claims 32-37 are rejected under 35 U.S.C. 103(a) as unpatentable over Jovicic et al. (US005855007A) in view of Narasimhan et al. (US006237145B1).

16. Jovicic et al. does teach (independent claim 32) a user computer coupled to the computer network (*Internet node 102*, col. 5 lines 24-26), the user computer enabling the user to select a reward for redemption from the list of rewards (in local storage, col. 8 lines 19-21) previously collected by the user and that are available for redemption. Jovicic et al. does not teach that said list of rewards is stored in a central computer database. Narasimhan et al. teaches that said list of rewards is stored in a central computer database (col. 6 lines 29-36). Because Narasimhan et al. teaches that server storage is more desirable than local storage (col. 1 line 54 to col. 2 line 11), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Narasimhan et al. to those of Jovicic et al.

17. Jovicic et al. also teaches at the citations given above claims and 33-37.

Response to Arguments

18. Applicant argues (pp. 12-13),

“The current Office Action re-opens prosecution by stating that ‘the subject limitation for all of the independent claims except claim 32 is in fact taught by the reference (as the *browsing memory 128*, at col. 6 lines 11-13, which was not previously cited by the examiner).’ (emphasis in original). First, the Board's Decision was quite clear that Jovicic does not disclose the feature in the claims. Col. 6, lines 11-13 of Jovicic, read as follows ‘...

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a browsing memory 128 where representative coupon or coupons are stored and ready for selection by users.’ There is nothing in this cited section or anywhere in Jovicic that states that coupons in the browsing memory are those ‘previously collected’ by the user.”

19. The examiner believes the Board erred in its implicit interpretation of "collected by the user". Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.
20. The instant application contains no such clear definition for the phrase "collected by the user". The phrase is disclosed at spec. col. 10 lines 1-2 (assuming "they" refers to "a user") and at spec. col. 13 lines 7-10. But these are example usages, which do not meet the requirements for a "clear definition." In the instant case, the examiner is required to give the term "collected by the user" its broadest reasonable interpretation, which the examiner judges to be any collection motivated or requested by the user. Jovicic et al. teaches that the rewards/coupons placed in *browsing memory 128* are personalized (col. 10 lines 22-30) based on demographic data provided by the user (col. 10 lines 12-17), which reads on rewards/coupons "collected by the user".
21. The phrase "collected by" is commonly understood to subsume the use of an agent. When works of art are said to have been "collected by" a patron or museum, it is commonly understood that said patron or museum did not literally go out and bring the pieces in themselves. It is understood that they likely requested and paid for the pieces while relying on one or more agents to actually do the collecting. See also the definition of "collect" in the Merriam-Webster Online Dictionary.

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22. The instant invention is similar: The user does not literally collect rewards. The instant application discloses that it is a computer which collects the rewards, based on the user's request. Hence, "collected by the user" is non-functional since it does not explicitly entail the use of a computer because it neither "tied to a particular apparatus" nor "operates to change materials to 'a different state or thing'" (*IN RE COMISKEY*, CAFC 2006-1286, September 2007).

Conclusion

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

24. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

26. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

27 May 2008

/Donald L. Champagne/

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Primary Examiner, Art Unit 3688